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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 10/501,941 | 05/23/2005 | Joan Seguer Bonaventura | TURK.P0131WOUS | 8468 |

7590 08/17/2007
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1621 Euclid Avenue
19th Floor
Cleveland, OH 44115

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| EXAMINER |
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LILLING, HERBERT J

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| ART UNIT | PAPER NUMBER |
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1657

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| MAIL DATE | DELIVERY MODE |
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08/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,941

Applicant(s)

BONAVENTURA ET AL.

Examiner

HERBERT J. LILLING

Art Unit

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>May 23, 2005</u> | 6) <input type="checkbox"/> Other: _____ |

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1. Receipt is acknowledged of an election response filed July 11, 2007.
2. Claims 1-20 remain pending in this application.
3. Applicant has elected species as noted (A)(ii)/(B)(c)(ii) and n=3 with traverse. However, Applicant has failed to expedite prosecution of this application as noted by paragraph 4 of the last office action, which stated:

"It is noted that the following may be rejected in the first office action based on the merits:

- a. Claim 1 "starting reactants of appropriate organic acid and alcohol" under 35 USC 112 first and second paragraph;
- b. Claims 14 and 19 "derived from fatty acids and esterified dibasic amino acids according to the following formula" under 35 USC 112 first and second paragraph;
- c. the expression in claims 7, 14 and 19 "and other substituted celluloses" in view of the expression "cellulose esters" under 35 USC 112 second paragraph."

The following rejections will be submitted based on the above supplied information. It will be noted that due to the lack of sufficient information as to the scope of the claimed invention, this Examiner will not search and examine the instant claims based on the above indicated rejections and if appropriate that the next office action will be made final. Prompt action is requested to correct the following problems as submitted in the following paragraphs.

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4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 14 and 19 are generic to the following problems which includes all claims 1-20 as being rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention with respect to the following:

a. Independent claims 1, 14 and 19 contain the following statement for the substrates which the instant specification fails to provide an enabling disclosure for the expression: "starting reactants of appropriate organic acid and alcohol" [claim1] and "derived from fatty acids and esterified dibasic amino acids according to the following formula" which specification has been found to be **totally defective** as to the scope of the "appropriate" organic acid and alcohol starting reactants and the expression "derived from fatty acids and esterified dibasic amino acids according to the following formula" [claims 14 and 19].

The language of the claims must make it clear what subject matter the claims encompass to adequately delineate their "metes and bounds" because before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover.

Claims 1-20 fail to comply with the above.

b. The term wherein "R₂" is "aromatic" has not been defined by the specification as to the scope, which includes several thousand compounds having aromatic for which the instant specification has been considered to be fatally defective.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention with respect to the above

a> and b>

as being vague and indefinite to the scope of the claimed subject matter as indicated that the language of the claims must make it clear what subject matter the claims encompass to adequately delineate their "metes and bounds" because before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover.

C> Claims 7, 14 and 19 contain a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by

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such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claims 7, 14 and 19 recites the broad recitation "cellulose esters" and the claim also recites: the terms "carboxymethyl cellulose" and "other substituted celluloses" both of which are the narrower statement of the range/limitation.

6. Receipt is acknowledged of the prior art, which has been made of record. However, an appropriate examination of the claimed subject matter cannot be properly made until the scope of the claimed subject matter has been made as to the "metes and bounds" of the claimed subject.

7. **No claim is allowed.**

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention based on the elected species, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

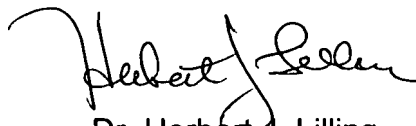
9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification..

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is 571-272-0918 and Fax Number is **571-273-8300**, or SPE Jon Weber whose telephone number is 571-272-0925. Examiner can be reached Monday-Friday from about 7:30 A.M. to about 7:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.J.Lilling: HJL
(571) 272-0918
Art Unit **1657**
August 10, 2007

A handwritten signature in black ink, appearing to read "Herbert J. Lilling", written in a cursive style.

Dr. Herbert J. Lilling
Primary Examiner
Group 1600 Art Unit 1657